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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,415	09/20/1999	STEVEN M. GONZALO		2237

25096 7590 11/04/2003

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EXAMINER

ST CYR, DANIEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/399,415

Applicant(s)

GONZALO, STEVEN M.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6-12 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. Receipt is acknowledged of the amendment filed 7/14/03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 6-10, 12, 13, 15, 16, 18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul, US Patent No. 5,991,875.

Paul discloses a configuration card system comprising: various audiovisual devices 10 such as a portable or desktop personal computer 12. Each of these devices may have a configuration card receiving slot 16. In each case, the configuration card receiving slot 16 is adapted to receive a configuration card. In operation, the configuration card 18 will be placed in the configuration card receiving slot 16 such that the configuration card 18 may be accessed by a processor 24 in the audiovisual device 10. The configuration card 18 may configure the audiovisual device 10 in accordance with the user's configuration preferences. Furthermore, the

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user may use his/her configuration card 18 in one or more of these audiovisual devices 10 to enable them and to have them boot up with the user's configuration preferences. In addition to the system configuration, the configuration card 18 may also configure access privileges of a user by providing web page blocking, thereby controlling access to various web pages (see figures 1-4; col. 3, line 28+).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 14, 17, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Reed et al, US Patent No. 5,862,325. The teachings of Paul have discussed above.

Paul discloses that the configuration card configures the user preferences including accessing the web, but Paul fails to disclose or fairly suggests the preferences include electronic mail, voice mail, bookmark, etc..

Reed et al disclose a computer base communication system and method for using metadata defining a control structure, which uses electronic/voice mail messages, bookmark etc. (see col. 13, lines 6-45).

In view of Reed et al's teaching, it would have been obvious for a person of ordinary skill in the art at the time was made to modify the of Paul by incorporating the electronic/voice mail and bookmark capability into the user's preferences so that the user could easily access his/her

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electronic phone book for communicating to his/her comrades and to effectively save favorite web page for easy access. Such modification would provide effective communication and prevent tedious writing of frequent URL address. Therefore, it would have been an obvious extension as taught by Paul.

Allowable Subject Matter

6. Claims 1-5 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

Although the prior art of record teaches a configuration card that contains information for configuring a computer of a user which includes user preferences, internet access, web browsing etc., the prior art of record fails to disclose or fairly suggest all the method steps for generating the card including receiving a request from the user computer, directing a program from the user computer to collect configuration information from the user computer, sending the configuration information to a card generating computer to generate the card, etc. The limitations in conjunction with other limitations in the claims were not shown by the prior art of record.

Response to Arguments

8. Applicant's arguments filed 7/14/03 have been fully considered but they are not persuasive. (see examiner remarks).

REMARKS:

In response to the applicant's argument regarding claims 6-8, the examiner respectfully disagrees. The card may be used to control access to certain web page (in order to gain/control access to web pages (home website), the browser must be configured to such task) (see col. 5, lines 57-63).

In respond to the applicant's argument regarding claim 9, the examiner respectfully disagrees. The card is used to communicate to remote location (accessing web page), information has to communicate to the web page central location to gain access to the web page.

Re argument of claim 10, Paul discloses resetting the browser (render the device inaccessible) (see col. 5, lines 63+).

Re argument of claim 15, the information from the user computer (device) is stored in the card (the is inherently collected to be store into the card) (see col. 4, line 15+).

In respond to the applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, an artisan would recognize the benefit to electronic mail, bookmark, etc., in the user preference to provide easy access.

The applicant's general arguments are not persuasive. Refer to the rejection above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.

DS
November 1, 2003